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DAC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



| | | |
|------------------------------|---|-----------------------------------|
| re Patent Application of: |) | Attorney Docket No. 23439-030-402 |
| James JOHNSON, <i>et al.</i> |) | Group Art Unit: 2764 |
| Serial No.: 09/840,080 |) | Examiner: Not yet assigned |
| Filed: August 24, 2000 |) | |

For: REMOTE VEHICLE EMISSIONS SENSING DEVICE WITH SINGLE DETECTOR

**REQUEST FOR RECONSIDERATION OF
PETITION UNDER 37 C.F.R. § 1.47(b)**

ATTN: Box DAC
Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

In response to the Decision Refusing Status Under 37 C.F.R. §1.47(b) ("Decision"), mailed February 21, 2002, Applicants respectfully submit this Request for Reconsideration addressing each of the issues raised in the Decision. Specifically, the Decision indicated that Applicants had failed to supply a Statement of the last known address for each of the non-signing inventors, proof that a copy of the application was sent or given to each of the non-signing inventors for review, proof that each of the non-signing inventors refused to signed and proof of irreparable damage.

STATEMENT OF LAST KNOWN ADDRESS

Regarding the Statement of Last Known Address for each of the non-signing inventors, Applicants respectfully submit that the last address known for each of the named inventors are believed to be as indicated on the unexecuted Declaration submitted with the Petition filed November 13, 2001. Those addresses are:

James H. Johnson
4401 West Crestfield Road
Tucson, Arizona 85475; and

John DiDomenico
8810 East Bear Paw Place
Tucson, Arizona 85749.

**PROOF THAT A COPY OF THE APPLICATION WAS
SENT OR GIVEN TO EACH OF THE NON-SIGNING INVENTORS**

Applicants respectfully submit Attachments A and B as further evidence that a copy of the application was sent to each inventor for their review. Attachment A is a letter, dated June 7, 2000, from Mr. Kevin J. Dunleavy to Mr. John DiDomenico enclosing the application and a Declaration and requesting that Mr. DiDomenico review the application and sign and return the Declaration. Mr. Dunleavy's letter also states that he had reviewed Mr. DiDomenico's comments regarding the application. This indicates that prior to June 7, 2000, Mr. DiDomenico had at least reviewed and commented on the application.

Attachment B is a letter from Mr. Kevin J. Dunleavy dated April 12, 2000 and addressed to Mr. James H. Johnson. The stated purpose of that letter is to forward the Declaration, Assignment and patent applications, including the present application, to Mr. Johnson for his review and signature. Therefore, Mr. Johnson had been sent a copy of the application at least no later than April 12, 2000.

PROOF THAT EACH OF THE NON-SIGNING INVENTORS REFUSED TO SIGN

In addition to the Facts indicating a refusal to sign by conduct, submitted with the Petition filed November 13, 2001, Applicants respectfully submit the following additional proof of inventor refusal to sign.

Attachment C is a June 8, 2000 letter from Mr. John DiDomenico to Kevin Dunleavy. In that letter, Mr. DiDomenico alleges that he does not understand the claims and, apparently, will not sign the application until further explanation is provided. As indicated in the Petition filed November 13, 2001, subsequent attempts to communicate with Mr. DiDomenico have been fruitless. As also indicated in the Petition filed November 13, 2001, attempts to communicate with Mr. James H. Johnson have also proven fruitless. Applicants respectfully submit that the conduct of both inventors indicates a refusal to execute the Declaration for patent application.

PROOF OF IRREPARABLE DAMAGE

According to MPEP §409.03(g), proof of irreparable damage may be shown by "a showing that the inventor may reasonably be expected to enter into competition with 37 C.F.R. §1.47(b) applicant." Applicants have re-submitted as Attachment D, a copy of the Declaration of Niranjan Vescio indicating that both Mr. John DiDomenico and Mr. James H. Johnson are believed to be employed by competitors to develop products that directly compete with the products of the 37 C.F.R. §1.47(b) applicant. Applicants respectfully submit that this is sufficient proof of irreparable damage according to MPEP §409.03(g), however, if additional proof is required, Applicants respectfully request further clarification.

The response period set by the Decision expires on **April 22, 2002** (April 21, 2002, being a Sunday). Accordingly, Applicants respectfully submit that this Response is timely filed, and no fees are due in connection with this filing. However, if it is determined otherwise, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0311 for any fees necessary to maintain the pendency of the application.

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. § 1.47(b)
U.S. PATENT APPLICATION SERIAL No.: 09/840,080
DOCKET No.: 23439-030-402

I, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and believe are believed true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO, PC

Dated: April 22, 2002

By: 

Christopher J. Cuneo
Registration No. 42,450

Mintz Levin Cohn Ferris Glovsky and Popeo, PC
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KEVIN J. DUNLEAVY
E-MAIL: KDUNLEAVY@HUNTON.COM



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DIRECT DIAL: (202) 955-1928
FILE NO.: 47382.000039

June 7, 2000

CONFIDENTIAL

Via UPS

Mr. John DiDomenico
8810 East Bear Paw Place
Tucson, Arizona 85749

**Re: Declaration and Assignment for U.S. Patent Application
Serial No. 09/480,699, Titled "Remote Vehicle Emission Sensing
Device With Single Detector" (Attorney Docket No. 47382.000039)**

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Dear John:

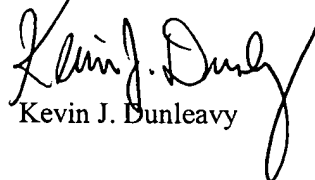
Review of your comments regarding the above-identified application indicates that your concerns with signing the Declaration for the above-identified application pertain only to the existence of a number of potential prior art publications. In order to fulfill your obligation under 37 C.F.R. § 1.56 (Duty to Disclose Information Material to Patentability) and alleviate your concerns, we have prepared an Information Disclosure document (PTO-Form 1449) that we will file with the executed declaration. The enclosed PTO-Form 1449 lists the documents that you have identified to us relating to this application.

Please review the above-identified application and sign and return the enclosed Declaration for Patent Application and Assignment at your earliest convenience in the enclosed, stamped, self-addressed envelope. We have not altered the application in any way since you last reviewed it.

Please feel free to call me if you have any questions. I look forward to receiving the executed Declaration and Assignment. Once we receive these documents, we will proceed to the next application.

Best regards.

Sincerely,


Kevin J. Dunleavy

Enclosures

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KEVIN J. DUNLEAVY
E-MAIL: KDUNLEAVY@HUNTON.COM

DIRECT DIAL: (202) 955-1928
FILE NO.: 47382.000039
47382.000041
47382.000102



April 12, 2000

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APR 24 2002

OFFICE OF PETITIONS

Mr. James H. Johnson
4401 West Crestview Road
Tucson, Arizona 85745

Re: Duty To Disclose Information To The United States Patent And Trademark Office

Dear James:

As you know, Envirotech has filed the following patent applications for which you are named as an inventor: (1) Application Serial No. 09/480,688, titled, "Remote Vehicle Emission Sensing Device With Single Detector," (2) Application Serial No. 09/457,391, titled, "Exhaust Opacity Measuring Device," and (3) Application Serial No. 09/520,166, titled, "Remote Emissions Sensing System With Improved NOx Detection." Under U.S. law, the inventors are obliged to sign a Declarations for Patent Application for each application. In addition, as part of the agreement you signed when you were hired, you are obliged to execute an Assignment of your rights in the patent application to Envirotech Systems Corp.

The purpose of this letter is to forward the Declarations, Assignments and patent applications to you for review and signature and to address some of the issues relating to you having to sign the Declarations for Patent Application. In this letter, I have provided you with detailed information regarding the duty of disclosure and I address your obligation to ensure the factual accuracy of the patent application.

Duty of Disclosure

The duty to disclose information to the United States Patent and Trademark Office ("PTO") arises out of the requirements of 37 C.F.R. § 1.56 -- Duty to Disclose Information Material to Patentability ("Rule 56"). This rule is reproduced in Chapter 2000 of the Manual of Patent Examining Procedure, which is attached, for your convenience, as Appendix A.

Rule 56 imposes on each individual associated with filing and prosecution of a patent application a continuing duty to disclose all information known to be material to the patentability of a pending claim. The duty continues until the claim is canceled or withdrawn or the patent issues. The claims of the patent applications are the numbered paragraphs found on the last few pages of the application text. A detailed discussion of what is required to be disclosed and when it must be disclosed is set forth in the following paragraphs.

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Mr. James H. Johnson
April 12, 2000
Page 2

Duty of Disclosure Requirements

A duty of candor and good faith toward the Patent and Trademark Office ("PTO") rests on each inventor who files a U.S. patent application, on each attorney or agent who prepares or prosecutes such application, and on every other individual who is substantively involved in the patenting process. ALL SUCH INDIVIDUALS HAVE A DUTY TO DISCLOSE TO THE PTO ANY AND ALL "INFORMATION" THEY ARE AWARE OF WHICH IS "MATERIAL" TO THE EXAMINATION OF THE APPLICATION. According to PTO rules, information is "material" if

it establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

it refutes, or is inconsistent with, a position the applicant takes in either opposing an argument of unpatentability relied on by the PTO or asserting an argument of patentability.

There is no duty to supply information which is already of record in the application.

The term "information" is used in its broadest sense. It encompasses what is commonly termed "prior art" and any other facts or circumstances which may be relevant. It also includes not only information which came into being before the application was filed, but also knowledge obtained or learned after the filing date. Common types of information which may be material to an application include, but by no means are limited to, the following:

- U.S. and foreign patents;
- Printed publications in the U.S. or foreign literature;
- Knowledge or use by others;
- Commercial activity, such as sales or offers for sale, of the invention;
- Prior inventions by any other inventors;
- Prior related work by the inventors;
- Co-pending applications by the same inventors or assigned to the same assignee;
- Co-pending applications having related subject matter; and
- Prior art cited in any co-pending application filed by the same inventors or assignee and having related subject matter.

Since the PTO expects all applicants to act with full candor, it is important that copies or written descriptions of any and all documents, facts or circumstances which might constitute material information be furnished to the PTO without delay. An appropriate rule of thumb is to disclose even borderline information to the PTO, thereby shifting the burden to the Examiner to decide whether such information is "material." Any other approach may render the patent vulnerable to a later finding of invalidity during the course of any infringement litigation.

HUNTON & WILLIAMS

Mr. James H. Johnson
April 12, 2000
Page 3

Your effort to uncover information material to the patentability of the applications for which you are listed as inventors is appreciated and encouraged. The serious nature of the Rule 56 duty is precisely why so much time was taken during the August 1998 invention disclosure meeting to inquire for each proposed application whether any disclosures, uses, sales, offers for sale, or any other material information existed. It is also why Patent Questionnaires were sent to the inventors before the filing of the utility applications and reminder letters explaining the continuing duty to disclose information to the PTO were sent to Environmental Systems Products ("ESP") (formerly Remote Sensing Technologies, Inc. ("RSTi")) upon the filing of each utility application (exemplary copies attached as Appendix B and Appendix C, respectively).

Once all inventors, assignee and attorneys involved have provided their comments, we will make a determination as to what materials warrant citation to the U.S. Patent Office using the applicable legal standards.

Obligation to Ensure Factual Accuracy of the Patent Application

By signing the Declaration for Patent Application, you swear that the factual information contained in the patent application is, to the best of your knowledge at the time of signing, factually correct.

With regard to the claims of the patent application, there are two reasons to consider the claims:

1. To ensure that you invented the subject matter of at least one claim contained in the patent application since by signing the Declaration you swear that you are the inventor of the subject matter of at least one claim, and
2. To determine what prior art you are aware of may be relevant to the patent application under the criteria set forth above.

Other than as specified above, you should not concern yourself with the scope of the patent claims since the owner of the patent, Envirotech Systems Corp., has the exclusive right to determine the scope of the patent claims that it intends to pursue.

I hope that this letter will simplify your task of reviewing and signing the patent applications. Please feel free to call me if you have any questions.

Best regards.

Sincerely,



Kevin J. Dunleavy

Enclosures

June 8, 2000

To: Kevin Dunleavy
Hunton and Williams

From: John DiDomenico

Re: Second Review of Patent Application No 09428992:

Kevin,

Since the patent has not changed, I'm assuming that none of the questions that were in my February letter to Jim have been addressed. I need answers to those questions before I can sign anything. You have to pardon my lack of remembrance. It's been close to two years since we originally talked on this application but how can I sign a patent when I the inventor don't understand the claims?

I included those questions from the February letter below.

Sincerely,

John DiDomenico

A large, stylized handwritten signature in black ink, starting with a large loop and extending horizontally to the right.

Page 3, line 20

I'm confused by the wording "aligned with the detector to the detector"? Should it not be just "aligned to the detector".

Page 6, lines 1 and 2

In what is represented in figure 2a, how do you get multiple detectors and why bring it up in an application for a single detector system?

Page 10, line 7 and 8

This would not work, as you constantly have to be measuring background emission before the vehicle enters the system. Therefore, the wheel has to be turning.

Page 20, claim 1

What is the intended meaning of "characteristic of a vehicle emission plume"? Can you do such a broad claim even though it's a "gas analysis device"?

Page 21, Claim 10

I'm not sure what you are claiming? What is happening in "a" and "d"?

Page 23, claim 18

Again, I can not visualize the complete claim. Could you give me a diagram?

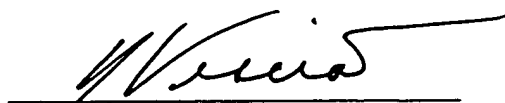
Declaration of Niranjan Vescio

I, Niranjan Vescio, hereby declare the following:

1. I am an employee of Envirotech Systems Corporation (ESC). My responsibilities include monitoring competitors.
2. On information and belief, John DiDomenico, and Craig S. Rendahl are employed by SPX Corporation (SPX) to develop products that directly compete with ESC products.
3. On information and belief, James H. Johnson was employed by MD LaserTech, LTD. (MD Laser) to develop products that compete with ESC products.
4. I have personally witnessed presentations, obtained promotional material and had discussions with other industry personnel that substantiate my belief that SPX and MD Laser are developing competing products.
5. At the 2000 CRC conference in San Diego, California, I personally witnessed Mr. Rendahl deliver a presentation in which he highlighted various aspects of SPX's plan to design, manufacture and market a remote sensing device to compete against ESP products.
6. At the 2001 CRC conference, I witnessed SPX present a poster that described progress made in the development of their remote sensing device. At that conference I witnessed Mr. John DiDomenico, as chief engineer for SPX, describe some of SPX's technical achievements. I also witnessed Dr. Glan Sachse, a NASA collaborator, elaborate on some of the technical aspects of SPX's products which are being developed to compete against ESP's remote sensing device.

7. I have visited the SPX website page (<http://www.shareholder.com/spx/news/20000719-18037.cfm>) (copy attached) that announces SPX's license to use NASA technology to develop a remote sensing device which will compete against ESP products. This same announcement quotes Mr. Rendahl as saying "we expect to begin manufacturing a highly enhanced remote sensing device before the end of 2001."
8. I have visited the MD Laser website (<http://www.md-lasertech.com/profile.html>) (copy attached) that describes MD Laser's products that are designed to compete with ESP products.
9. I have obtained a promotional CD-ROM disk that describes SPX's interest in developing a remote sensing device that competes with ESP products.
10. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: Aug. 1, 2001


Niranjana Vescio
Title: Technical Marketing Director

SPX Corporation

[REDACTED]

SPW \$116.25 +1.5 4:03 PM ET - Sep 3

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Press Releases

SPX Service Solutions to Adapt Nasa Satellite Technology to Monitor Vehicle Pollution

KALAMAZOO, MICHIGAN - JULY 19, 2000 – SPX Service Solutions, a unit of SPX Corporation (NYSE:SPW) today announced that it has received the exclusive license to use patented NASA technology for use in developing a new remote sensing device to monitor motor vehicle exhaust.

Cities and states may soon have a new high-tech tool in the battle against automotive air pollution, thanks to NASA satellite technology originally developed to track global greenhouse gases and the Earth's protective ozone layer. As envisioned, NASA's atmospheric remote sensing technology will be adapted to an autonomous roadside system to monitor motor vehicle emissions.

Cars and trucks will pass through a low-power light beam, without stopping or slowing down. Space-age sensor technology will instantly analyze vehicle exhaust pollutants important to local and state governments working to meet federally mandated air quality standards.

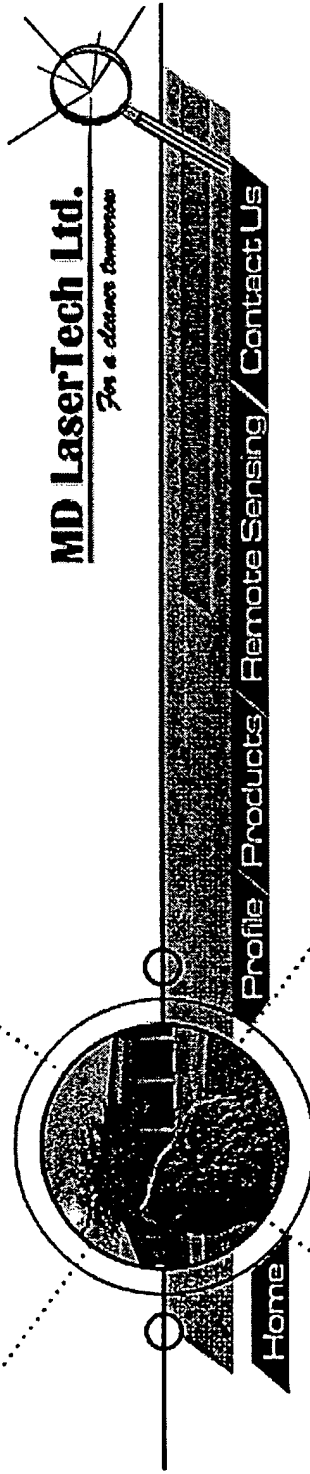
"Taking an accurate reading of several exhaust products as a car passes by is a formidable challenge. We want to take a measurement of all the gases of interest every one thousandth of a second over a period of a half-second. Fortunately, our newest remote sensing technology has that capability," said Glen Sachse, senior research scientist at NASA Langley Research Center, Hampton, VA. Sachse is one of six team members who invented the highly sensitive electro-optical system at the core of the technology.

"Remote testing of vehicle exhaust will provide governments around the world with a fast, efficient and low-cost method to identify and reduce motor vehicle air pollution and greenhouse gases, which account for approximately half of all air pollution," said Craig Rendahl, Remote Sensing business leader for SPX Service Solutions.

"With the number of vehicles on the road increasing every year, we believe there is a significant global market for technology of this nature," said Rendahl. "SPX will offer a basic unit which will be available at the end of 2000. With the help of NASA, we expect to begin manufacturing a highly enhanced remote sensing device before the end of 2001. This second-generation product will contain many other features, including the capability to test heavy-duty diesel vehicles."

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Remote Sensing Systems



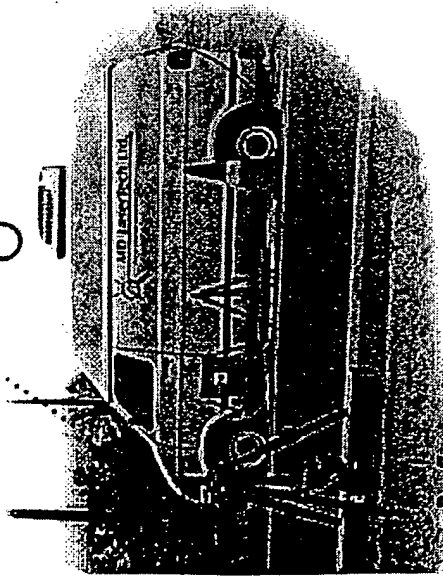
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Company Profile

MD LaserTech was founded in 1998 to provide high quality remote sensing services and technology to states and government agencies as a complement their vehicle emissions control programs.

Highly experienced remote sensing and emissions systems development personnel founded MD LaserTech. The team has many years experience in the development, deployment, manufacture and operation of vehicle emissions testing and remote sensing technology and equipment.

MD LaserTech offers the industry's most advanced remote sensing systems for 2-Gas, 4-Gas and diesel opacity emissions analysis. In addition to products for emissions applications, MD LaserTech also offers advanced remote sensing systems for speed limit enforcement.



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